

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference Wi-hf-01988	FOR FURTHER ACTION		See item 4 below
International application No. PCT/EP2004/013254	International filing date (<i>day/month/year</i>) 22 November 2004 (22.11.2004)	Priority date (<i>day/month/year</i>) 03 December 2003 (03.12.2003)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant BEIERSDORF AG			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 7 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | |
|---|---|
| <input checked="" type="checkbox"/> Box No. I | Basis of the report |
| <input type="checkbox"/> Box No. II | Priority |
| <input type="checkbox"/> Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI | Certain documents cited |
| <input type="checkbox"/> Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70		Date of issuance of this report 29 August 2006 (29.08.2006)
Form PCT/IB/373 (January 2004)		Authorized officer Agnes Wittmann-Regis e-mail: pt06@wipo.int

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

TRANSLATION
PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing (day/month/year) **See form PCT/ISA/210**

Applicant's or agent's file reference

Wi-hf-01988

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/EP2004/013254

International filing date (day/month/year)

22.11.2004

Priority date (day/month/year)

03.12.2003

International Patent Classification (IPC) or both national classification and IPC

A61K31/365, A61K31/121, A61K35/78, A61K7/48, A61K7/42, A61P17/00

Applicant

BEIERSDORF AG

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

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Box No. I

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	1-13	YES
	Claims		NO
Inventive step (IS)	Claims		YES
	Claims	1-13	NO
Industrial applicability (IA)	Claims	1-13	YES
	Claims		NO
2. Citations and explanations:			
I. <u>Prior art documents</u>			
D1: SHIBATA S ET AL: "INHIBITORY EFFECTS OF LICOCHALCONE A ISOLATED FROM GLYCYRRHIZA-INFLATA ROOT ON INFLAMMATORY EAR EDEMA AND TUMOR PROMOTION IN MICE" PLANTA MEDICA, vol. 57, no. 3, 1991, pages 221-224, XP009045109 ISSN: 0032-0943			
D2: US-B1-6 214 352 (MATSUKAWA SHINYA) 10 April 2001 (2001-04-10)			
D3: WO 03/070152 A (COGNIS DEUTSCHLAND GMBH & CO. KG; EGGERS, ANKE; HIRSINGER, FRANK; MOSE) 28 August 2003 (2003-08-28)			
D4: PATENT ABSTRACTS OF JAPAN vol. 2003, no. 11, 5 November 2003 (2003-11-05) & JP 2003 201214 A (SHISEIDO CO LTD), 18 July 2003 (2003-07-18)			
D5: DATABASE WPI Section Ch, Week 200281 Derwent Publications Ltd., London, GB; Class B04, AN 2002-748666 XP002320778 & KR 2002 046 615 A (COREANA COSMETICS CO LTD) 21 June 2002 (2002-06-21)			
1. Novelty (PCT Article 33(2))			
The subject matter of the independent claims of the present application appears to be novel because it			

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Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

is contained in none of the documents of the
available prior art.

D1 and D2 do not disclose 2,3-dibenzylbutyrolactone
derivatives.

D3, D4, D5 do not disclose Licochalcone A or an
extract comprising Licochalcone A.

2. Inventive step (PCT Article 33(3))

The subject matter of the present claims 1-13 does
not involve an inventive step.

According to the present application (page 13, lines
3-21), a combination of 2,3-dibenzylbutyrolactone
derivatives and Licochalcone A is used for improving
a series of skin conditions, for example to combat
inflammations, skin ageing, pigmentation.

The effectiveness of Licochalcone A against
inflammations, pigmentation was known from D1 (page
224, section with the title "Discussion") or D2
(column 3, line 11-18).

The effectiveness of 2,3-dibenzylbutyrolactone
derivatives, such as, for example, arctiin or
arctigenin against skin ageing, inflammations,
pigmentation was likewise known from D3 (page 2, 2nd
paragraph - page 3, 3rd paragraph), D4 (abstract)
and D5 (abstract). The claimed combination thus
produces no effects which were not already known
from the prior art. In the present application,
further effects are neither disclosed nor verified
experimentally. The claimed combination is thus to
be regarded as arbitrary and noninventive.

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Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

II. P documents

P1: WO 03/099244 A (BEIERSDORF AG; STAEB, FRANZ; WOLBER, RAINER; BLATT, THOMAS; KOLBE, LUD) 4 December 2003 (2003-12-04)

P2: WO 03/101414 A (BEIERSDORF AG; TOM DIECK, KAREN; KOLBE, LUDGER; MUNDT, CLAUDIA; WENSOR) 11 December 2003 (2003-12-11)

A decision as to the validity of the claimed priority of these documents was not possible since the priority document was not available at the time of the examination.

In the case of a valid priority, P1 and P2 do not form part of the prior art within the meaning of PCT Rule 64.1(b) (P doc).

However, should the priority claimed by the applicant not be valid, P1 and P2 would be relevant for the inventive step of the present claims.

P1 does not disclose Licochalcone A or an extract comprising Licochalcone A.

P2 does not disclose 2,3-dibenzylbutyrolactone derivatives.

The effectiveness of 2,3-dibenzylbutyrolactone derivatives against skin ageing, pigmentation, and the effectiveness of Licochalcone A against inflammations, skin dryness were known from P1 (page 4, line 1 - page 5, line 6; page 6, line 12 - page 7, line 35) and P2 (page 7, line 31 - page 9, line 13). The claimed combination thus does not produce any effects which were not already known from the prior art. In the present application,

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Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

further effects are neither disclosed nor verified experimentally. The claimed combination is thus to be regarded as arbitrary and noninventive.

3. Conclusion

In the absence of an additional surprising effect caused by the claimed combination it is not evident which part of the application could form the basis for a new, allowable claim.